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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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G.E. EHRLICH (1995) LTD.
c/o ANTHONY CASTORINA
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,875

Applicant(s)

KATZ ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 46-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 46-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-42 and 46-79 have been examined.

Priority

Acknowledgment is made of applicant's claim for priority based on US Provisional Application No. 60/324,914 filed 9/27/2001.

Drawings

2. The drawings are objected to because of inconsistency in the representation of the objects. Object 24 in Fig. 1 represents "Fail Ctr." but in Fig. 2 object 24 represents some other entity. Similarly, object 30 is a memory unit in one instance and a PDA in another. Applicant should check for and correct similar inconsistencies in the drawings.

No new matter may be entered.

3. Furthermore "Item F" in Fig. 4 is not addressed in the specification.
4. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so

as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of inconsistency in addressing entities of the invention. For example pg. 13 line 11 refers to object 23 as "the authentication communicator" but pg. 15 line 4 introduces object 23 as "a timer".
6. Applicant is required to check and address similar inconsistencies in the specification.

No new matter may be entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 42 and 79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
8. Claims 42 and 79 refer to an indication that the activity request is approved and recite that the indication is outputted by applying a change to a routing table on a router. However, the specification does not teach how communication of the authentication is achieved by changing a routing table.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

10. In claims 2-11, 37, 63 and 74, the following lack antecedent basis:

- a. Claim 10: "said secure link" and "said secure mobile device",
- b. Claims 2-9 and 11: "said authenticatable link",
- c. Claims 37 and 74: "said authorization",
- d. Claim 63: "said reply",
- e. Claims 76-78: "output".

11. It appears as claim 1 includes method steps and it is not clear how method steps relate to a claim to an apparatus.

12. Furthermore, claims 1 and 46 recite: "...an associator for associating the verification with an activity request via a non authenticatable device..." It is not clear whether a subject of "via a non authenticatable device" is "associating" or "an activity request".

In addition the connection between "associating the verification with an activity request" and "authentication of the activity request" is not understood. It is not clear whether the claim language suggests that associating the verification should be interpreted as authentication or whether there is some other meaning, not explicitly mentioned within the claim language.

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For purposes of further examination claim 1 and 46 are being treated as best understood.

13. The claim language uses the terms "authenticatable" and "non- authenticatable".

These terms are not clear.

The specification recites: "In the present context, a non-authenticatable link is a link through which users or requesting devices cannot be positively identified, and particularly includes general Internet connections", which makes the matter even more ambiguous. There are many objects that make a link (such as Internet connection) "authenticatable", e.g. cookies, password, certificates etc. Similarly smart cards not only can be authenticated but also smart cards can be used for authentication. Compare this with applicant's statement: "In an alternative embodiment, the non-authenticatable device may be a credit card or a smart card..."

At the same time in the abstract of the invention applicant discloses:

"communicating via a secure link with an authenticatable device, using secure personalization associated with said authentication portal and said authenticatable device, typically a mobile telephone having a SIM, to verify that the communication is with the intended user". The examiner points out that SIM is a type of smart card.

For purposes of further examination the phrase is treated as best understood.

Clarification is required.

14. Claims 2-9, 16 and 47-54 recite acronyms: WAP, GSM, CDMA, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium (directed to network links and associated

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devices) that are not described in the specification. For purposes of further examination the acronyms are treated as different network links.

15. Claims 18 and 19 recite acronyms: EMS and MMS that are not described in the specification. For purposes of further examination the acronyms are treated as different electronic messaging.

16. Claims 30-32 and 69-70 recite that the apparatus connects to non-authenticable devices via Bluetooth, infra-red or WLAN access points but not details in regard to these technologies are provided in the specifications. For purposes of further examination the Bluetooth, infra-red and WLAN are treated as alternative connection means to non-authenticable devices.

17. Claims 20-23 and 61-62 recite limitations completed by "therewith/thereby to authorize said activity request". It is not clear whether an initializing communication should be treated as authorization of the activity request as the claim language suggests or whether the claims are missing some limitations.

18. Claims 37 and 74 use the term "said authorization". The term is not understood since previous claims refer only to authentication. In light of the specification ("*A timer 23 is operated, giving the owner of the mobile telephone a fixed time to reply and confirm the identity of the user*") the term is treated as authentication.

19. Claim 24 is convoluted. The phrase: wherein said communication comprises functionality to insert an identifier into said reply for a requesting party to enter via said non-authenticatable device" is not clear as to what "to enter" refers. It is not clear whether the requesting party enters something (that is missing in the limitation language) or whether the requesting party is a subject of entering (e.g.

enters some kind of state that also is not mentioned in the language) or whether there is some other interpretation of the claim.

20. Claim 63 is unclear. Claim 63 follows (depends on) the limitation of claim 62, which recites steps of receiving a message from an authenticatable device, resulting in sending a response to the authenticatable device. Claim 63 recites "inserting a password into said reply for a requesting party". It is unclear whether inserting is completed by the authenticatable or by a non-authenticatable device.
21. Claims 42 and 79 refer to an indication that the activity request is approved and recite that the indication is output by applying a change to a routing table on a router. However, the specification does not teach how communication of the authentication is achieved by changing a routing table. The limitation is especially unclear since no motivation is provided for such an action and no clear connection between the routing table and authentication is shown in the specification. For purposes of further examination it is assumed that the routing table allows data routing to and from (only) authenticated entities.
22. The use of the trademarks has been noted in this application (*e.g. Bluetooth in claims 36 and 73*). Where a trademark or trade name is used in claims as a limitation to identify or describe a particular material or product, the claims do not comply with the requirements of 35 U.S.C. 1 12, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claims scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In

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the present case, the trademark/trade name is used to identify/describe an operating system and; accordingly, the identification/description is indefinite.

23. Claims 12-15, 17, 25-29, 33-36, 38-41, 48-53, 55-60, 64-68, 71, 73, 75 and 79 are rejected by virtue of their dependence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

24. Claims 1-3, 10-15, 17, 25-27, 29, 33, 35-36, 39-42, 6-48, 55-56, 58-60, 64-66, 68, 71, 73 and 76-78 are rejected under 35 U.S.C. 102(e) as being anticipated by *Boyle et al. (U.S. Patent No. 6138158)*.

25. As per claims 1 and 46 *Boyle et al.* teach a network with a mobile device (116) communicating with a web server (112) using a carrier network (102) and a gateway (114) (Fig. 1). *Boyle et al.* disclose that each of the mobile devices is assigned a device ID (col. 8 lines 33-37).

This reads on a communicator for communicating with an authenticatable mobile device and on a verifier associated with said authenticatable mobile device to verify that the communication is with an intended one of authenticatable devices.

26. *Boyle et al.* further teach that the (mobile) device ID is associated with a subscriber ID authorized by a carrier in a server device, which associates a respective user account in the server device to a unique device ID (114, *Fig. 3 and col. 8 lines 38-51*). This reads on an associator for associating the verification with an activity request via a non authenticatable device, thereby to authenticate the activity request of the non-authenticatable device.
27. As per claims 2-3, 10-12, 13-15, 17, 25-27, 29, 33, 36, 39-42, 47-48, 56-57, 58-60, 64-66, 68, 71 and 73, 76-78 *Boyle et al.* teach network involving mobile devices and other computers (*Fig. 1*), the link server authenticating the mobile device using the device ID (*col. 14 lines 21-38*). *Boyle et al.* also disclose that is associated to a respective user account (114, *Fig. 3 and col. 8 lines 38-51*), and that user pay for electronic exchange activity (*col. 7 line 65-col. 8 line 6*), discloses that the invention has particular applications to the navigation of Internet web pages (*Abstract*), as well as accounts for various networks as a communication carrier networks, e.g. GSM and CDMA. *Boyle et al.* also teach a mobile phone (*Fig. 1*), SMS messaging (*col. 9 lines 35-38*) and email (*col. 10 lines 18-52*).
28. Claims 4-9, 16, 18-24, 28, 30-32, 34, 38, 49-55, 61-63, 67, 69-70, 72, 75 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Boyle et al.* (U.S. Patent No. 6138158).
29. As per claims 4-9, 16 and 49-55 *Boyle et al.* teach the authentication device and the authenticatable link (*link with authenticatable device*) as discussed above. *Boyle et al.* do not explicitly teach that the authenticatable device is WAP, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium links, and that the authenticatable

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link is WAP, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium. However, the use of various network protocols to connect authenticatable and non-authenticatable devices is old and well-known practice, and using WAP, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium links with associated devices would have been obvious to one of ordinary skill in the art at the time of applicant's invention. One of ordinary skill in the art would have been motivated to use various network protocols such as WAP, CDMA, IS-136, PDC, EDGE, WCDMA, GPRS and Iridium links with associated devices in order not to limit the invention to certain types of technologies.

30. As per claims 18 and 19 *Boyle et al.* teach electronic data communication comprising electronic messaging as discussed above.

Boyle et al. do not explicitly teach EMS and MMS. However, it is old and well-known practice to use various electronic messaging protocols and using EMS and MMS would have been obvious to one of ordinary skill in the art at the time of applicant's invention. One of ordinary skill in the art would have been motivated to use various types of electronic messaging protocols such as EMS and MMS in order not to allow devices with multiple electronic messaging protocols (*such as EMS and MMS*) to utilize *Boyle et al.*'s invention.

31. As per claims 30-32 and 69-70 *Boyle et al.* do not explicitly teach connecting to non-authenticatable devices via Bluetooth, infra-red or WLAN access points. Using various technologies to connect to non-authenticatable devices is old and well-known practice. One of ordinary skill in the art would have been motivated to use various technologies such as Bluetooth, infra-red or WLAN in order to connect to

authenticable in order not to limit *Boyle et al.*'s invention to only a certain number of technologies.

32. As per claims 37 and 74 *Boyle et al.* do not explicitly teach timing the communication to fail the authentication if the communication is not completed by a predetermined time limit.

Official Notice is taken that it is old and well-known practice to time communication and fail the authentication if the communication is not completed by a predetermined time limit. One of ordinary skill in art at the time of applicant's invention would have been motivated to employ timing in order to increase security.

33. The limitations of claims 20-23 and 61-62 are implicit. Devices (such as telephones) can initiate communications and may respond to the communication initiated by another device. Similarly implicit are claims 34 and 72 so that a mobile telephone device could be contacted.

34. As per claim 63 *Boyle et al.* teach use of a password (*col. 8 lines 52-64*).

35. Similarly claim 24 (as best understood) is implicit. Communicating devices comprise the functionality of inserting identifiers and verifying has functionality to determine from where data has been received, especially when provided with an identifier.

36. The limitation of claim 79 is implicit. Once activity is authenticated the communication should be allowed.

37. As per claims 28 and 67 *Boyle et al.* do not teach that the requested activity is a point of sale activity.

Official Notice is taken that it is old and well-known practice to utilize devices (such as telephones) to conduct activity such as to purchase transactions for the benefit of convenience and speed.

38. As per claims 38 and 75 *Boyle et al.* do not teach log-in functionality for logging in the non-authenticatable device.

Official Notice is taken that it is old and well-known practice to log in to the non-authenticatable devices (e.g. voice mail system). One of ordinary skill in the art at the time of applicant's invention would employ log-in functionality for logging in to non-authenticatable devices in order to prevent unauthorized access to information.

39. Claims 37 and 74 are rejected under 35 U.S.C. 103(a) as unpatentable over *Boyle et al.* (U.S. Patent No. 6138158) in view of *Huang* (U.S. Patent No. 6192361).

40. *Boyle et al.* teach authentication as discussed above.

Boyle et al. do not teach to time the communication to fail the authentication if the communication is not completed by a predetermined time limit.

Huang teach timing the communication to fail the authentication if the communication is not completed by a predetermined time limit (*Huang*, col. 15 lines 43).


It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to time the communication to fail the authentication if the communication is not completed by a predetermined time limit. One of ordinary skill in the art would have been motivated to perform such a modification in order to increase the system security.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature
5/27/5
Date

GREGORY MORSE
SUPERVISORY PATENT
TECHNOLOGY CENTER 2134

